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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,951	11/26/2001	Chit Wei Saw	10012969-1	5223

22879 7590 01/09/2004

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/991,951

Applicant(s)

SAW ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-17 and 20 is/are rejected.
- 7) ☒ Claim(s) 8,10,18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 12, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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1. Claim 2 recites the limitation "the thickness dimension" in line 2. There is insufficient antecedent basis for this limitation in the claim.
2. Claim 12 which is dependent on claim 11 recites the limitation of "the font variation". However, if a "font size, spread and font weight" were selected out of the typeface parameters listed and not a font variation, Claim 12 would be indefinite.
3. Claim 14 recites the limitation "the thickness dimension" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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4. Claims 1, 2, 4, 13, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Michaelis et al (2002/0057453).

Michaelis et al discloses a cover authoring tool and method comprising: an interface (microprocessor and program memory a stated in Col. 2, Par. 12, and in ) for receiving size data information for a document to be bound into a book, having a spine characterized by a width dimension (thickness. Par. 14, and for receiving graphical and textual content information for a cover (Par. 13) to be attached to a bound book; a cover content layout engine (Fig. 2) configured to compose a final content layout for the cover, including spine content formatted to accommodate the book dimensions based upon document size and cover content information received through the interface (Par, 15 and par. 21), wherein the cover content layout engine is configured to compute the thickness dimension (Par. 21, lines 3 and 4).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Kosasa et al (5,735,659).

Kosasa et al discloses in Fig. 1-2A, a bookbinding system comprising a sheet composer configured to format a document to be bound (202); a sheet binder (203) configured to form a text body of two or more sheets having an exposed spine characterized by dimensions; a cover authoring tool comprising an interface (306) configured to receive size information and content

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information for a cover, a cover content layout engine (317) configured to compose a final content layout for the cover including the spinal content to accommodate the dimensions for the book spine and cover content (Col. 9, lines 44-58); and a cover binder (203) configured to attach the cover to the text body.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaelis et al in view of Carlson et al (WO-01/00423).

Michaelis et al discloses a cover authoring tool comprising all the elements as claimed in Claims 1 and 2 and as set forth above. However, Michaelis et al does not disclose wherein the received document size information includes type of paper and number of pages in the bound book.

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Carlson et al discloses in the Abstract wherein the received information for the cover content layout engine includes the type of paper and the number of pages in the book.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Michaelis et al's cover authoring tool with received information comprising type of paper and number of pages included as taught by Carlson et al for the purpose determining the size requirements for the cover.

7. Claims 5-7, 15, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaelis et al in view of Tonkin (6,616,702).

Michaelis et al discloses a cover authoring tool and method comprising all the elements as claimed in Claims 1 and 4 and as set forth above. However, Michaelis et al does not disclose wherein the interface comprises a graphical user interface in which a user may specify the content and content layout for the cover; and wherein the interface is configured to compose the final content layout for the cover based upon a pre-generated cover style.

Tonkin discloses in Col. 6, lines 62-65, a graphical user interface (Fig. 5A and 5B) in which a user may specify the content and content layout for the cover (Col. 11, lines 20-50) based upon multiple pregenerated cover styles (Col. 7, lines 38-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Michaelis et al's cover authoring tool and method with a

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graphical user interface as taught by Tonkin for the purpose of allowing the end user to edit book contents and the cover layout to user's specifications.

8. Claims 9, 11, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaelis et al in view of Kosasa et al (5,735,659).

Michaelis et al discloses a cover authoring tool and method comprising all the elements as claimed in Claim 1, and as set forth above. However, Michaelis et al does not disclose wherein the content cover layout engine is configured to select the typeface parameters (which include the font size) for spinal text content consisting of a number of characters; and wherein the typeface values are selected from the group consisting of one of the following typeface parameters: font size, spread, stretch font variation, and font weight.

Kosasa et al discloses in Col. 9, lines 44-58 wherein a content layout engine (thickness detection sensor is configured to select the typeface parameters for the spinal text content, wherein the typeface values consist a font size parameter. (Col. 9, lines 53-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Michaelis et al's cover authoring tool with a content layout engine configured to select the typeface for the spinal text as taught by Kosasa et al for the purpose of reducing the bookmaking manufacturing time by having the system itself calculate the correct parameters to print on the cover spine.



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***Allowable Subject Matter***

9. Claims 8, 10, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

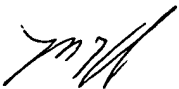
***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Kalisher, Wang, Trosterud, Salzberger, Georgitsis et al, Williams et al, Zahn, Williams, Garrido, Celorio Garrido ('890) disclose similar cover authoring tools.

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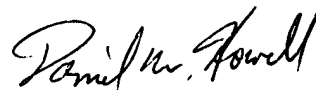
### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

January 5, 2004



Daniel W. Howell  
Primary Examiner  
Art Unit 3722